

REMARKS

Applicants acknowledge receipt of the *Final Office Action* dated December 19, 2005 wherein: (1) claims 1-5, 7, 8, 10, 11, 14-20, 22, 23, 25, 26, 29 and 30 were rejected under 35 U.S.C. § 102(b); (2) claims 9, 12, 13, 24, 27 and 28 were rejected under 35 U.S.C. § 103(a); and (3) claims 6 and 21 were objected to as being dependent upon a rejected base claim, but would otherwise be allowable.

Status of the Claims

Claims 1, 3-16 and 18-30 are pending.

Claims 1 and 16 are currently amended.

Claims 2 and 17 are currently cancelled.

Allowable Subject Matter

Claims 6 and 21 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants acknowledge with appreciation the allowability of claims 6 and 21.

Claim Rejections under 35 U.S.C. § 102(b)

Claims 1-5, 7, 8, 10, 11, 14-20, 22, 23, 25, 26, 29 and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,678,635 to Dunlap et al. (hereinafter *Dunlap*). *Dunlap* discloses a bridge plug assembly 10 including an anchor mechanism 12 comprising upper and lower independently moveable slips 52 and 54 that are moveable from a collapsed position shown in Figures 1 and 4 to an expanded position shown in Figure 7 where the slips 52, 54 engage a surrounding casing C. To set the anchor mechanism 12, a setting tool ST exerts a downward force on an upper expander 56, which causes the upper expander 56 and a lower expander 58 to move axially toward each other (col. 6, lines 27-40). This action forces two additional upper expanders 68, 72, and two additional lower expanders 70, 74 to slide relative to each other, and also relative to the slips 52, 54 to wedge the slips 52, 54 radially outwardly toward the casing C as shown in Figure 7 (col. 6, line 63 to col. 8, line 3).

Referring to Figure 4, slidable interconnections are provided between each of the upper expanders 56, 68, 70 and the upper slip 52 via dovetail keys (not labeled) that are secured within upper slots 76 disposed in each of the expanders 56, 68, 70. The dovetail keys are positioned on the radially inward side of each expander 56, 68, 70 and each slip 52. Upper limit pins 77 disposed within limit slots 71 also secure the upper expanders 56, 68, 70 and the upper slip 52 together and limit the extent of sliding movement. Similar interconnections are formed between the lower expanders 58, 70, 74 and the lower slip 54 via lower slots 78, lower limit pins 79, and limit slots 71. These slidable interconnections allow relative substantially longitudinal movement while preventing rotation of the expanders and slips (col. 7, lines 3-28).

As set forth in MPEP §706.02(IV), in order for a reference to anticipate the invention as claimed, the reference must disclose each and every element recited in the claims. The *Final Office Action* states that *Dunlap* discloses the “plurality of angled channels” recited by claim 1 and claim 16, namely, the angled slots 76, 78 in the upper expanders 56, 68, 70 and the lower expanders 58, 70, 74, respectively. The *Final Office Action* also asserts that *Dunlap* discloses a “plurality of extensions corresponding to and engaging the channels”, namely limit pins 77, 79.

In response, Applicants respectfully traverse the characterization of the *Dunlap* angled slots 76, 78 as corresponding to the claimed “plurality of angled channels.” In particular, the slots 76, 78 are formed through rather than into a wall of the tool. Applicants also respectfully submit that neither the *Dunlap* dovetail keys nor the *Dunlap* limit pins 77, 79 are structurally or functionally equivalent to the claimed “plurality of extensions” as asserted in the *Final Office Action*. Structurally, the claimed plurality of extensions are disposed along a side surface of each slip, and such extensions correspond to and engage the plurality of angled channels in the body or the slip housing according to amended claim 1 and amended claim 16. In contrast, the dovetail keys and the limit pins 77, 79 are positioned on a radially inward surface of each slip 52, 54 rather than along a side surface, and each of these components form only a point of connection between the slips 52, 54 and the expanders 72, 74.

Functionally, due to the differences in design, the slips 52, 54 of *Dunlap* are point connected to the expanders 72, 74 by the dovetail keys and limit pins 77, 79. These slidable interconnections function to allow relative substantially longitudinal movement while preventing rotation of the expanders and slips. However, the slips 52, 54 translate along inclined surfaces of the expanders 72, 74 between the collapsed position and the expanded position. In contrast, the

plurality of extensions disposed along a side surface of each slip according to claim 1 and claim 16, as amended, function to fit within corresponding angled channels and translate along those channels between the collapsed position and the expanded position. Thus, the angled channels in the body or the slip housing form a track into which the extensions fit for sliding engagement, and this interconnection provides an increased surface area of contact for a more robust expandable tool. Further, the side surface placement of the plurality of extensions enables an interconnection between the slips and the body or the slip housing such that the channels and extensions support the slips in the expanded position.

Accordingly, Applicants submit that at least for the foregoing reasons, *Dunlap* fails to disclose each and every element recited in the pending claims, and therefore independent claim 1 and independent claim 16 are each patentably distinguishable over *Dunlap*. Further, pending claims 3-5, 7, 10, 11, 14 and 15 are in condition for allowance over *Dunlap* at least because each of these claims depend from allowable claim 1. Likewise, pending claims 18, 19, 20, 22, 23, 25, 26, 29 and 30 are in condition for allowance over *Dunlap* at least because each of these claims depend from allowable claim 16.

Claim Rejections under 35 U.S.C. § 103(a)

Various of claims 9, 12, 13, 24, 27 and 28 stand rejected as being unpatentable over *Dunlap* in combination with either U.S. Patent No. 5,318,818 to Baker (hereinafter *Baker*), U.S. Patent No. 6,164,377 to Roberts (hereinafter *Roberts*), or U.S. Patent No. 5,878,818 to Herbert et al. (hereinafter *Herbert*). Applicants respectfully submit that the combination of *Dunlap* with another of the cited references does not establish a *prima facie* case of obviousness as to claims 9, 12, 13, 24, 27 and 28. According to MPEP 2142, three basic criteria must be met to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Even assuming for the sake of argument that the combination of *Dunlap* with another of

the cited references is proper (without conceding such), Applicants submit that no *prima facie* case of obviousness has been established with respect to pending claims 9, 12, 13, 24, 27 and 28 at least because such a combination fails to teach or suggest all of the claim limitations. In particular, claims 9, 12 and 13 each depend from and incorporate the limitations of independent claim 1, and as previously presented, *Dunlap* does not disclose the claimed "plurality of extensions disposed along a side surface of each slip of said plurality of moveable slips, said plurality of extensions corresponding to and engaging said plurality of channels." Similarly, claims 24, 27 and 28 each depend from and incorporate the limitations of independent claim 16, and as previously presented, *Dunlap* does not disclose the claimed "plurality of extensions disposed along a side surface of each slip of said at least one pair of individual slips, said plurality of extensions corresponding to and engaging said plurality of channels." None of the other cited references is relied upon to teach or suggest the claimed plurality of extensions. Therefore, given that *Dunlap* does not teach the claimed plurality of extensions and thus does not make obvious each and every element of claim 9, 12, 13, 24, 27 and 28, and none of the other cited references make up for the lack of teaching of *Dunlap*, Applicant respectfully submits that claims 9, 12, 13, 24, 27 and 28 are not obvious in view of the prior art of record.

CONCLUSION

Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections is respectfully requested by Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the *Final Office Action* dated December 19, 2005 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,

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